REMARKS/ARGUMENTS

Claims 23- 33 are pending in the present application. Claims 23, 27, 30, and 33 are amended. Support for the claim amendments can be found in the claims as originally filed. No new matter is added. Reconsideration of the claims is respectfully requested.

Applicants have amended claims 23, 27, 30, and 33. Applicants do not concede that the subject matter encompassed by the earlier presented claims is not patentable over the art cited by the Examiner. Applicants amended claims 23, 27, 30, and 33 in this response solely to facilitate expeditious prosecution of this application. Applicants respectfully reserve the right to pursue the claims as presented prior to this amendment, and additional claims, in one or more continuing applications.

I.   35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 23-33 under 35 U.S.C. § 103 as unpatentable over *Brown* (U.S. 6,618,062) in view of *Cogen* (US Pat Pub 2002/0138350 A1) and in further view of *Ukeda* (US Pat Pub 2004-0068631). Applicants respectfully traverse the rejection.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006).

Applicants have amended claim 23 as follows:

> 23.   A computer implemented method for communicating dining preferences
> of a customer to an establishment, the computer implemented method
> comprising:

storing a plurality of dining preferences for a set of different and unrelated restaurants by restaurant name in a memory of a personal storage device, in response to receiving a personal identification certificate, wherein each dining preference comprises a selection of food items corresponding to a menu associated with the restaurant identified by the restaurant name, wherein the restaurant is one in the set of different and unrelated restaurants and wherein the each dining preference further comprises food preparation preferences, wherein the plurality of dining preferences comprises a first set of dining preferences and a second set of dining preferences, and wherein the first set of dining preferences is identified by a first restaurant name and the second set of dining preferences is identified by a second restaurant name;

retrieving, by a data processing system in the first restaurant, the first set of dining preferences identified by the first restaurant name from the portable storage device, wherein the second set of dining preferences are not retrieved;

displaying the first set of dining preferences, on a display in the first restaurant, for order verification, wherein the second set of dining preferences stored on the portable storage device are not displayed;

responsive to receiving an input from the customer verifying the first set of dining preferences, generating a verified first set of dining preferences; responsive to receiving the verified first set of dining preferences, generating a food order using the first set of dining preference; and

storing the first set of dining preferences on an order system in the first restaurant.

I.A.   _Brown_ **in view of** _Cogen_

The Examiner cites to _Brown_ as teaching the features of claim 23. _Brown_ states:

According to the method and system of the preferred embodiment, computer system 10 retrieves food menu items 42 from data storage medium 40, retrieves food preferences 46 from PSD 48, compares food menu items 42 with food preferences 46, and selects a food menu wherein those food menu items which satisfy food preferences 46 are designated. Computer system 10 then outputs the specified electronic food menu.

In some cases, food menu items that do not satisfy food preferences 46 may be able to satisfy food preferences 46 if a particular ingredient or ingredients are removed or if a replacement ingredient is utilized. For example, at a restaurant that serves chocolate milkshakes, a customer that specifies no caffeine in their food preferences would receive a specified electronic food menu where caffeine would be shown as the reason the food menu item does not satisfy their food preferences. In addition, the electronic food menu would show specifically that the chocolate syrup in the food menu item contains the caffeine. The customer may then order the chocolate milkshake with an indication not to add chocolate syrup. In the same example, the chocolate milkshake may be made with 2% milk that has a greater amount of fat per serving than the food preferences for the customer allow. The specified electronic food menu would indicate that the milkshake does not satisfy the food preferences because of the fat content of the milk.

The customer may then request that skim milk be utilized in making the milkshake instead of 2% milk.

Preferably, as a customer removes or substitutes ingredients, the overall dietary value of a food menu item is recalculated and other fields are updated in order that the food menu item can be compared with the food preferences again and the specified electronic food menu updated. In addition, as the customer selects food menu items, an overall dietary value of the food menu items selected is preferably calculated.

Brown, col. 5, lines 19-54.

Brown describes a restaurant computer system retrieving food preferences from a customer's personal storage device and comparing the preferences to the restaurant's food menu items. When the computer system identifies a match between the food preferences and the food menu items, a food order is generated. *Brown* further teaches that when food menu items do not satisfy the customer's food preferences, the customer can remove or substitute ingredients so that a match can be created. However, *Brown* does not teach or suggest that the restaurant is in a set of different and unrelated restaurants, as acknowledged by the Examiner. The Examiner asserts that *Cogen* makes up for the deficiency of *Brown* in teaching this feature.

Cogen teaches a menu application that utilizes menus from a plurality of restaurants and storing menu selections for each restaurant on a customer's handheld computer. The menu selections are organized by unique names and stored in separate files on the handheld computer. *Cogen* further teaches that any number of files can be saved and each file comprises all the selections for a particular order. However, the teachings of *Cogen* cannot be combined with the teachings *Brown* because the proposed combination changes the principle operation of *Brown*. In combining references to show the claimed feature, the proposed modification cannot change the principle of operation of a reference. See *In re Ratti*, 270 F.2d 810, 123 (CCPA 1959) and MPEP 2143.01. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Id.

The food preferences in *Brown* are stored in a single file, not in separate files as taught in *Cogen*. The invention in *Brown*, would have to be redesigned to read from multiple files instead of a single file. Moreover, when the personal storage device of *Brown* is presented to a restaurant, the restaurant computer system begins comparing the food preferences against the restaurant menu, regardless whether the preferences are associated with that particular restaurant. This is in contradistinction to the claimed invention which teaches that when the dining preferences identified by a specific restaurant are retrieved, that specific restaurant is unable to see the menu selections of other restaurant dining preferences stored on the personal storage device. The Examiner's proposed combination of *Brown* and *Cogen* changes the principle operation of *Brown*. Therefore in accordance with *In re Ratti*, a *prima facie* obviousness rejection cannot be stated against claim 23.

I.B.   **Brown and Cogen in further view of Ukeda**

The Examiner also acknowledges that that combination of *Brown* and *Cogen* fails to teach or suggest the feature of storing information in response to receiving a personal identification certificate. The Examiner asserts that *Ukeda* teaches this feature citing to the following portion:

> [0010] According to one aspect of the invention, after an information distributor authenticates a storage device by using a first certificate, data including at least multimedia information is transferred from the information distributor to the storage device, the memory device stores the data and transfers the data stored in the storage device to an information browser after authenticating the information browser by using a second certificate, and further, when receiving an input of identification information determined by a user or the like from the information browser, the storage device compares the inputted identification information with identification information stored in advance in the storage device and in accordance with a result of the comparison, transfers arbitrary information different from the multimedia information and readable according to the second certificate to the information browser.

Ukeda, paragraph [0010].

Ukeda teaches authenticating a storage device using a first certificate. Information on a storage device is then transferred to an information browser after authenticating the information browser using a second certificate. However, *Ukeda* does not teach or suggest that the information on the storage device is stored after receiving a personal identification certificate from a user. *Ukeda* does not teach or suggest the feature "storing a plurality of dining preferences by restaurant name in a memory of a personal storage device, in response to receiving a personal identification certificate. . ." as claimed in claim 23. *Ukeda* fails to make up for the deficiencies of the combination of *Brown* and *Cogen*. Therefore, the combination of *Brown*, *Cogen* and *Ukeda*, considered as a whole, fails to teach or suggest each and every feature of claim 23. Accordingly, a *prima facie* obviousness rejection cannot be stated against claim 23.

II.   **Remaining Claims**

Claims 30 and 33 recite similar subject matter with regard to claim 23. Independent claims 30 and 33 are not obvious for the reasons stated above with regard to similarly recited subject matter. Dependent claims 24-29, and 31-32 depend from claims 23 and 30. Therefore, dependent claims 24-29, and 31-32 are not obvious. Accordingly, the rejection under 35 U.S.C. 103 is overcome.

III.   **Objection to Claims**

The Examiner has stated that claims were objected to because the number of the claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to preserved. Applicants have renumbered the claims. Accordingly, Applicants request this objection be withdrawn.

IV. **Conclusion**

It is respectfully urged that the subject application is patentable over the cited reference(s) and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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